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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,884	11/13/2001	Hiroyuki Onishi	U 013711-6	5111

140 7590 07/26/2005

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NY 10023

EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,884

Applicant(s)

ONISHI ET AL.

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-68 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 11-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8-10 and 67 is/are rejected.
- 7) ☒ Claim(s) 68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

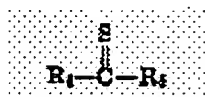
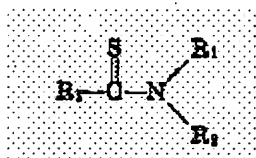
- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Amendment***

1. Receipt is acknowledged of applicant's amendment and response, filed 06 May 2005. Claims 1 and 4-68 remain pending, of which, claims 4-7 and 11-66 have been withdrawn from consideration.

Response to Arguments

2. Applicant's arguments, filed in the above-mentioned response, with respect to the art rejections based on Mones, have been fully considered and are persuasive. Applicant has amended the claim to delete thiourea. Since Mones teaches only thiocarbonyl compounds of the form:



Mones neither teaches nor suggests the remaining sulfur compounds recited in the claim. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Shimamura et al. (US 3,782,945 A), which teaches a hetero-ring-containing thiol compound (see below).

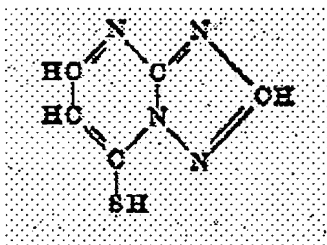
Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 9, 10, and 67 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimamura et al. (US 3,782,945 A).

Art Unit: 1762

With respect to claim 1, Shimamura teaches a process in which a photographic element having a latent image thereon (anticipates claimed "recorded matter comprising a recording medium in which images are recorded") is over-coated with a protective layer containing a tetra-azaindene compound, an example of which is 1,3,3a,7-tetra-azaindene-4-thiol:



It is the examiner's position that this compound, as well as the other thiols disclosed at 2:55-4:50, anticipate applicant's claimed "hetero-ring-containing thiol compound." See 1:15-5:45, especially 5:39-43.

With respect to claim 9, insofar as one may write on a photographic element (i.e., a photograph) with a pen, marker, etc., the photographic element of Shimamura anticipates applicant's claimed ink receiving layer disposed on a support.

With respect to claim 10, it is the examiner's position that Shimamura's disclosure of the application of "a protective layer" anticipates applicant's claimed "coating treatment."

With respect to claim 67, Shimamura teaches that the purpose of the tetra-azaindene is to develop the latent image on the photographic element (2:23-28). Insofar as a developed photographic element is no longer sensitive to light (i.e., the image becomes fixed and cannot be exposed/developed again), this teaching anticipates applicant's claimed improved light resistance. Insofar as the protective layer constitutes a physical barrier covering the photographic image, it inherently provides some impediment to impinging gas molecules and hence anticipates applicant's claimed improved gas resistance.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. **Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimamura et al. (US 3,782,945 A).**

The teaching of Shimamura is detailed above.

This reference does not teach that the protective layer additionally comprises at least one of the recited compounds.

It is the examiner's position that resinous binders (both natural and synthetic) are well known in the photographic art as protective coatings. Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Shimamura so as to utilize a resin binder to form the protective coating. One of ordinary skill in the art would have been motivated

Art Unit: 1762

to do so by the desire and expectation of successfully providing a protective coating on the photographic element.

Allowable Subject Matter

9. Claim 68 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

The prior art neither teaches nor suggests the claimed process in which the sulfur compound is thiocyanate or thiosulfuric acid.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1762

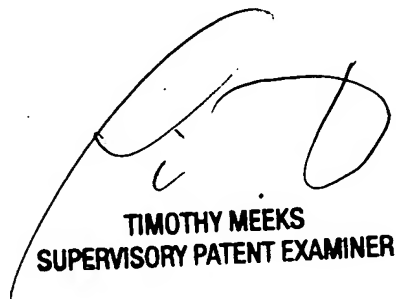
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPF 7/21/2005

William Phillip Fletcher III
Patent Examiner, USPTO
Art Unit 1762


**TIMOTHY MEKS
SUPERVISORY PATENT EXAMINER**